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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/625,999

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Lee Doerksen

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EXAMINER

DUNHAM, JASON B

ART UNIT

PAPER NUMBER

3625

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

12/28/2006

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/625,999

Applicant(s)

DOERKSEN ET AL.

Examiner

Jason B. Dunham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 9-20, 22-43 and 63-78 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-20, 22-43 and 63-78 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Applicant amended claims 1-7,9-20,22-29,33-38,42-43, and 63-74, canceled claims 8,21, and 44-62, and added in claims 75-78 in the response filed August 9, 2006 in response to the office action dated May 9, 2006. Claims 1-7,9-20,22-43, and 63-78 are pending in this application. Paragraph 41 of the specification was amended.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7, 9-20, 22-43, and 63-78 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bonneau (U.S. Patent No. 6,978,273) in view of Moore (U.S. Patent Application Publication No. 2002/0143603).

Referring to claim 1. The combination of Bonneau and Moore discloses a method for producing a customized catalogue comprising pages for a catalogue retailer for delivery to a targeted recipient in physical form comprising:

- Acquiring targeted recipient data, wherein the targeted recipient data comprise historical transaction data specific to the targeted recipient, wherein the targeted recipient data are updated periodically, and wherein the historical transaction

data relate to transactions between the targeted recipient and the catalogue retailer (Moore: paragraphs 4-5);

- Creating a targeted recipient profile from the targeted recipient data (Bonneau: column 4, lines 36-53);
- Applying a set of offering rules to the targeted recipient profile to select one an offering from offerings stored in an offerings database (Bonneau: column 4, lines 36-53);
- Acquiring a set of product assets associated with the selected offering (Bonneau: abstract & column 4, lines 36-53);
- Generating a customized catalog specification file for the targeted recipient using the set of product assets (Bonneau: column 3, lines 30-38 & column 4, line 54 – column 5, line 2); and
- printing the customized catalogue using the customized catalogue specification file (Bonneau: column 3, lines 3-17).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have modified the method of Bonneau to have included using targeted recipient data comprising historical transaction data, as taught by Moore, in order to predict customer purchases for customizing direct marketing materials (Moore: abstract).

Referring to claim 2. The combination of Bonneau and Moore further discloses a method wherein the historical transaction data are selected from the group consisting of purchase history (Moore: paragraph 5).

Referring to claim 3. The combination of Bonneau and Moore further discloses a method wherein the set of product assets comprises elements selected from the group consisting of text, graphics, and photographs (Bonneau: abstract & column 4, lines 36-53).

Referring to claim 4. The combination of Bonneau and Moore discloses a method wherein generating a customized catalogue specification file for the targeted recipient using the set of product assets associated with the selected offering comprises:

- Applying a set of ranking rules to the selected offering to determine a relevancy ranking (Bonneau: column 5, lines 18-33); and
- Applying a set of page allocation rules to allocate space within the customized catalogue for the selected offering using the relevancy ranking (Moore: abstract & figures 4-6).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have modified the method of Bonneau to have included applying a set of page allocation rules, as taught by Moore, in order to optimize the layout to increase the likelihood of a product being purchased (Moore: abstract).

Referring to claim 5. The combination of Bonneau and Moore further discloses a method comprising applying a set of layout rules to the set of product assets associated with the selected offering to acquire a layout attribute consistent with allocated space for the selected offering (Moore: abstract & figures 4-6).

Referring to claim 6. The combination of Bonneau and Moore further discloses a method wherein the layout attribute is selected from the group consisting of a text, font, text size, graphic dimensions, photograph dimension, and photograph resolution (Bonneau: abstract & column 4, lines 36-53).

Referring to claim 7. The combination of Bonneau and Moore further discloses a method wherein the customized catalogue comprises a product section, and wherein applying the set of page allocation rules to allocate space within the customized catalogue for the selected offering based on the relevancy ranking comprises:

- Establishing in the product section a number of offerings per page (Moore: figure 6); and
- Assigning the product assets of the selected offering to a page of the product section in accordance with the number of offerings per page (Moore: figures 4-6).

Referring to claim 9. The combination of Bonneau and Moore further discloses a method comprising:

- Determining a page count of the pages of the customized catalogue (Moore: paragraph 35);
- Determining if the page count comprises an even signature (Moore: paragraph 35); and
- If the page count does not comprises an even signature, applying a signature rule to force the page count to comprise the even signature (Moore: figures 6-8).

Referring to claims 10-12. The combination of Bonneau and Moore further discloses a method wherein the signature rule comprises deleting or adding pages

comprising filler pages (Moore: figures 6-8). The examiner notes that Moore discloses optimizing the layout of products in order to use all available space and produce a customized catalogue with complete pages, see Moore, paragraph 61.

Referring to claim 13. The combination of Bonneau and Moore further discloses a method comprising applying a boost factor to an offering stored in the offerings database prior to applying the set of offering rules to the targeted recipient profile (Moore: abstract). The examiner notes that Moore discloses optimizing the layout of the catalogue in order to maximize profits, akin to "boosting" products due to manufacturer's preferences.

Referring to claim 75. The combination of Bonneau and Moore further discloses a method wherein the targeted recipient data further comprises customer demographic information consisting of customer preferences (Bonneau: column 3, lines 1-29).

Referring to claim 14. The combination of Bonneau and Moore disclose all of the above as noted in the rejection of claims 1-13 and further disclose a method for producing a customized catalogue comprising pages for a catalogue retailer for delivery to a targeted recipient in physical form comprising:

- Applying the set of catalogue rules to the targeted recipient profile to make a determination whether to produce the customized catalogue for the targeted recipient (Moore: abstract); and
- If the customized catalogue is produced for the targeted recipient, applying the set of catalogue rules to the targeted recipient profile to make a determination of the number of pages in the targeted recipient's customized catalogue (Moore:

abstract & figures 4-6). The examiner notes that the modifier "if" gives this limitation little patentable weight.

Referring to claims 15-20, 22-26, and 76. Claims 15-20, 22-26, and 76 are rejected under the same rationale as set forth above.

Referring to claim 27. The combination of Bonneau and Moore discloses all of the above as noted under the rejection of claim 1 and further discloses a customized catalogue publication system for producing a customized catalogue comprising pages for a catalogue retailer for delivery to a targeted recipient in physical form comprising:

- A profiler, wherein the profiler is adapted to create a targeted recipient profile from the targeted recipient record (Bonneau: column 4, lines 36-53); and
- A rules engine adapted to:
 - Apply the set of offering rules to the targeted recipient profile to select an offering from the offerings (Bonneau: column 4, lines 36-53);
 - Acquire the set of product assets associated with the selected offering (Bonneau: abstract & column 4, lines 36-53); and
 - Generate a customized catalogue specification file for the targeted recipient using the set of product assets (Bonneau: column 3, lines 30-38 & column 4, line 54 – column 5, line 2); and
 - A printing system adapted to receive the customized catalogue specification file and print the customized catalogue according to the customized catalogue specification file (Bonneau: column 3, lines 3-17).

Referring to claim 28. Claim 28 is rejected under the same rationale as set forth above.

Referring to claim 29. The combination of Bonneau and Moore further discloses a customized catalogue publication system, wherein the printing system comprises:

- A printer (Bonneau: column 3, lines 3-17); and
- A file translation system adapted to convert the specification file to a format compatible with the printer (Bonneau: column 3, lines 3-17).

Referring to claims 30-32. The combination of Bonneau and Moore further disclose a customized catalogue publication system wherein the printer is a web-fed printer, sheet-fed printer, or a toner, liquid ink, or ink-jet based printer (Moore: figure 1). The examiner notes that the type of printer is not given much patentable weight.

Referring to claims 33-43 and 77. Claims 33-43 and 77 are rejected under the same rationale as set forth above.

Referring to claim 63. The combination of Bonneau and Moore discloses all of the above as noted in the rejections of claim 1 and further discloses a method for producing a customized catalogue comprising pages for a catalogue retailer for delivery to a targeted recipient in physical form comprising:

- Assigning the targeted recipient to a target recipient group based on the targeted recipient profile of the targeted recipient and a member profile of each member of the targeted recipient group (Bonneau: column 5, lines 39-60);

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- Imputing attributes of the targeted recipient group to the targeted recipient profile of the targeted recipient to create a revised targeted recipient profile for the targeted recipient (Moore: abstract).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have modified the method of Bonneau to have included assigning attributes of the customer group to the profile of the targeted recipient, as taught by Moore, in order to produce a customized catalogue to increase the likelihood of a product being purchased (Moore: abstract).

Referring to claims 64-74 and 78. Claims 64-74 and 78 are rejected under the same rationale as set forth above.

Response to Arguments

Applicant's arguments and amendments filed August 9, 2006, with respect to the 35 U.S.C. 112, second paragraph rejection have been fully considered and are persuasive. The previous 35 U.S.C. 112, second paragraph rejection of claims 1-26 and 63-74 has been withdrawn.

Applicant's arguments with respect to claims 1-3 have been considered but are moot in view of the new ground(s) of rejection. Applicant argues that Bonneau does not disclose printed the customized catalogue by citing the discussion of the prior art. The examiner, however, cited column 3, lines 3-17 of Bonneau disclosing, "In this way, a set of search results is generated for each rule set that can be used to create virtual custom

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catalogs or physical manifestations thereof." Clearly, Bonneau anticipates producing a printed catalogue.

Applicant's arguments filed August 9, 2006 regarding claim rejections under 103(a) have been fully considered but they are not persuasive.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Bonneau and Moore both related to methods and systems for producing custom catalogs based upon user information. Moore further discloses methods and system for the producing the layout of the custom catalog and it would be have been obvious to modify Bonneau in order to optimize the layout to increase the likelihood of a product being purchased, as noted above in the rejection of claim 4. As the teachings of Moore would be utilized in modifying the layout of Bonneau, the examiner disagrees with the applicant's contention that combining the references would render the method of Bonneau unsatisfactory for its intended purpose.

Independent claims 14,27, and 63 and the dependent claims of 1,14,27, and 63 are rejected under the same rationale set forth above.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason B. Dunham whose telephone number is 571-272-8109. The examiner can normally be reached on M-F, 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JBD
Patent Examiner
12/21/06


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